APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,675	10/02/2000	Frank Hagebarth	Q60673	4764

7590 06/18/2004			EXAMINER
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC			ODLAND, DAVID E
2100 Pennsylvania Avenue, N.W.			

ART UNIT	PAPER NUMBER
2662	8

Washington, DC 20037-3213

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _02 April 2004_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-19_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5 and 8-19_ is/are rejected.

7)☒ Claim(s) _6 and 7_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _02 April 2004_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The following is a response to the amendments filed on 04/02/2004.

Drawings

2.   Regarding the Replacement Sheets filed with the amendments on 04/02/2004, the

Applicant is reminded that in addition to these Replacement Sheets containing the corrected

drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet

including annotations indicating the changes made to the previous version. The marked-up copy

must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the

amendment or remarks section that explains the change(s) to the drawings. See 37 CFR

1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the

abandonment of the application.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
> the subject matter, which the applicant regards as his invention.

4.   Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

        Claims 18 and 19 recite that the call from the server is not accepted if the server is

recognized. This limitation is confusing because the parent claims (claims 1 and 12,

respectively) of claims 18 and 19 recite that the calls *are* (emphasis added) accepted when the

server is recognized, thus the claims seems to contradict one another and it is unclear whether the

call is accepted or rejected when the server is recognized.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by

McMullin (USPN 5,809,128), hereafter referred to as McMullin.

Referring to claim 1-5, McMullin discloses a method of activating an inactive terminal

a data network characterized by the following steps: establishing a connection to a server of the

data network (a caller, wishing to call a network subscriber, establishes a connection from the

callers terminal to a proxy (see items 44a and 38 of figure 38)) and transmitting an identifier of

the terminal to be activated to the server of the data network (the subscribers number is sent to

the proxy (see figures 2 and 3)), receiving the identifier at the server of the data network (the

proxy receives the subscribers number (see figures 2 and 3)), interpreting the identifier at the

server of the data network to determine the telephone number of the terminal be activated (the

proxy performs a DNIS/ANI lookup, thus it has interpreted the number it receives from the caller

(see figures 2 and 3)); making a call from the server of the data network through the telephone

network the terminal be activated (the server calls the subscriber through the PSTN (see figures 2

and 3)), signaling the identity of the server of the data network through the telephone network to

the terminal to be activated (the proxy communicates to the subscriber's computer using IP

packets which have source addresses and these packets are sent through the PSTN to the

subscriber (see figure 2 and column 6)), receiving the telephone call and interpreting the

signaling at the terminal be activated (the subscriber receives a notification from the proxy (see

figure 2 and columns 10 and 11)), terminating the telephone call to the terminal by the server of

the data network (the proxy sends the notifications and signaling to the subscriber (see figure 2

and columns 10 and 11)) and establishing a connection from the terminal to be activated to the

data network if the signaling indicates that the telephone call came from a server of the data

network (the subscriber is notified of the incoming call from the server and the subscriber can

accept the call and establish communication with the caller through the use of the subscribers PC

(see figure 2 and columns 10 and 11);

the establishment of the connection to the server of the data network and the transmission

of the identifier of the terminal to be activated the server of the data network are effected by the

further terminal (the caller makes a call to the subscriber using the subscribers phone number

(see figure 2 and column 6));

in order to establish a connection between the further terminal and the terminal to be

activated, the terminal to be activated establishes a connection to a server of the data network

(when the subscriber decides to communicate with the caller the subscriber indicates so to the

proxy (see figure 2 and columns 10 and 11)) and transmits its identifier to the server or the

identifier is determined by the server (the subscriber transmits IP packets to the proxy which

have source addresses in them (see figure 2 and columns 10 and 11)), the data network addresses

of the two terminals are transmitted by the server of the data network to the respective other

terminal or are retrieved by the terminals from the server (IP packets have both source and

destination addresses in them (see figure 2 and columns 10 and 11)), and connection is

established by the terminals through the telephone network and the data network (a connection

between the subscriber and the caller is established (see columns 10 and 11));

the data network is designed an as Internet Protocol network (the data network is an the

Internet (see column 6));

the further terminal is a calling party's terminal connected to telephone network (the

caller has a terminal connected to the PSTN (see figure 2)) and in that the terminal to be

activated is a called party's terminal connected to the telephone network (the subscribers

computer is connected to the PSTN (see figure 2)) the called party's terminal being activated to

set up a voice call between the calling party's terminal and the called party's terminal through the

IP network (the subscriber sets up a connection with the caller through the Internet (see figure 2

and columns 10 and 11)).

Referring to claim 8-11, McMullin discloses a server of a data network (a proxy server of

a data network (see figure 2)), characterized by means for receiving from a terminal an identifier

of a terminal to be activated, which connected to a telephone network (the proxy receives a

phone number of a subscriber connected to the PSTN and to whom a caller wishes to contact

(see figure 2 and column 6)) means for making a telephone call over the telephone network to

the terminal to be activated (the proxy contacts the subscriber through the PSTN (see figure 2))

and means for terminating the telephone call to the terminal to be activated (the proxy can

terminate the call by the caller in various ways, such as voice mail functions (see figure 2 and

columns 10 and 11));

the server is designed as an access server in an IP network (the proxy can be implemented

in the Internet and serves to provide access to a subscriber by the caller (see figure 2 and

columns 10 and 11));

the server further comprising means for interpreting the identifier and determining the

telephone number of the terminal to be activated (the proxy interprets the subscribers number

entered by the caller in order to perform a look-up function (see figure 3));

the server further comprises means for accepting a telephone call received from the

terminal over the telephone network and means for establishing a connection from the terminal

the data network (the proxy comprises means for implementing calls from the subscriber to the

caller that traverse through the PSTN and Internet (see figure 2 and columns 10 and 11)).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

8.   Claims 12-19, as best understood, are rejected under 35 U.S.C. 103(a) as being

unpatentable over McMullin in view of Rahikainen et al. (USPN 6,085,080), hereafter referred to

as Rahikainen.

Referring to claim 12 and 15-19, McMullin discloses an adapter unit characterized by means for establishing a connection from the terminal to a server of a data network over the telephone network (the subscriber using his or her computer can establish a connection to the proxy through the PSTN (see figure 2 and columns 10 and 11)), means for receiving a telephone call of a server of the data network (the proxy connects a call with the subscribers computer (see figure 2 and columns 10 and 11)), means for interpreting a number of a caller (the callers number is displayed to the subscriber by the subscribers computer (see figure 2 and columns 10 and 11)), means for retrieving and/or receiving a data network address of a further adapter unit of the caller from the server of the data network (the proxy sends the subscriber the phone number of the caller (see figure 2 and columns 10 and 11)) and means for establishing a data call to the further adapter unit through the data network (the subscriber uses his or her computer to establish a call with the caller (see figure 2 and columns 2 and 3)). Note, regarding claim 17, McMullin discloses the microcomputer as a personal computer (see figures 1 and 2).

McMullin does not disclose comparing caller and server telephone numbers in order to determine weather to accept or reject the call. However, Rahikainen discloses a system wherein the telephone numbers of incoming calls are compared to numbers on a restricted list and a determination is made as to whether to accept or reject the associated incoming calls (see column 5 lines 7-39). It would have been obvious to one skilled in the art at the time of the invention to implement this feature in the McMullin system because as Rahikainen points out, in column 2 lines 30-41, such a feature would make the system more user-friendly and flexible by allowing users of the system to selectively restrict and/or reject calls from taking place.

Referring to claims 13 and 14, McMullin discloses the system discussed above.

Furthermore, McMullin discloses means for transmitting the identifier of a terminal to be

activated or the identification of a called party to the server of the data network (the caller sends

the phone number of the subscriber he or she is trying to call to the proxy and also the subscriber,

when he or she decides to communicate with the caller through the computer, sends the callers

address to the proxy in an IP packet so that the proxy knows where to send the packet when it is

received (see figure 2 and columns 10 and 11));

characterized by being implemented as a processor, a memory, an interface to the

telephone network, and an interface to an Internet Protocol (IP) network (the subscribers

computer has a processor, a memory and interfaces to the PSTN and Internet (see figure 2 and

columns 10 and 11)).

Allowable Subject Matter

9.   Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would

be allowable if rewritten in independent form including all of the limitations of the base claim

and any intervening claims.

Response to Arguments

10.   Applicant's arguments filed 04/02/2004 have been fully considered but they are not

persuasive.

On page 15 first paragraph the Applicant contends that the present invention differs from

McMullin because McMullin relies on a proxy and modem connection whereas the present

invention relies on "telephone network identification signaling" to alert the called party's adapter

of the incoming call. The Examiner respectfully disagrees. Firstly, none of the claims recite that

a proxy and/or a modem connection *cannot* be used and for this reason McMullin is still a proper

reference. Furthermore, McMullin uses DNIS, ANI and standardized E.164 telephone numbers

along with their associated signaling for processing the calls (see figures 1 and 2 and column 7

lines 42-49), therefore McMullin discloses using "telephone network identification signaling".

On page 15 paragraph two, the Applicant implies that the Examiner is using IP-based

signaling in McMullin and not "telephone" signaling. The Examiner respectfully disagrees.

Although McMullin shows that the communication between the calling and called party may

take place *in-part* (emphasis added) over a data network using the Internet Protocol, the calls are

still sent and received over the PSTN and send and received by standard POTS phones and local

loop lines (see figure 2), therefore indeed McMullin discloses using "telephone" based signaling.

Also note that since the signaling that is transported in-part over the IP-based data network has to

do with telephone calls between the two subscribers, this signaling can be broadly interpreted as

"telephone" signaling even though is travels over the data network.

Conclusion

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Odland, who can be reached at (703) 305-3231 on Monday

– Friday during the hours of 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hassan Kizou, can be reached at (703) 305-4744. The fax number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist, who can be reached at (703) 305-4750.

deo

June 8, 2004
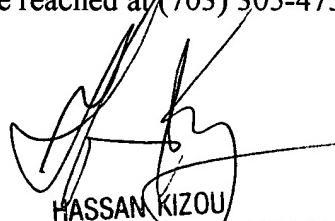
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